



Docket H10108RAR
Customer No. 01333

2622
AP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Tomas Roztocil, et al

SYSTEM AND METHOD FOR VISUAL
REPRESENTATION OF TABS IN A
PRODUCTION PRINTING
WORKFLOW

Serial No. 09/803,166

Filed 09 March 2001

Group Art Unit: 2622

Examiner: Marie Twyler Lamb

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Debra Nowacki
Debra Nowacki

January 3, 2005
Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Transmitted herewith is an amendment in the above-identified application:

No additional fee is required.

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	(Col. 1)		(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		* HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL	54	MINUS	54	0	X 18	\$0
INDEP	3	MINUS	3	0	X 88	\$0
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM				+ 300		\$ 0
				TOTAL		\$0

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Any patent application processing fees under 37 CFR 1.17.
(For Extensions of Time and other Petitions to the Assistant Commissioner)

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Attorney for Applicants
Registration No. 33,766



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Response

This communication is in response to the Office Action Dated October 5, 2004.

Claims 1-3, 15 and 35 are rejected as being obvious over Suzuki et al. in view of Mackay.

In order to establish a prima facie case of obviousness, it is necessary to present evidence that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. In the present case, the only suggestion for the proposed combination improperly stems from applicant's disclosure and not from the isolated teachings of Suzuki et al. and Mackay.

There is no suggestion in Suzuki et al. and Mackay to teach applicant's method except by a hindsight process. It is impermissible to first ascertain factually what applicant did and then view the prior art in such a manner as to select from that art only certain portions which are reconstructed to meet applicant's invention. It is not realistic when deciding obviousness to pick and

choose from any one reference only so much as will support a given proposition and then add to another reference when there is no suggestion to do so.

Not only must the claimed combination be considered as a whole, but the prior art references must also be considered in their entireties to determine whether they suggest the desirability of making the combination. Applicant's structure clearly defines over the reference when considering the prior art disclosures as a whole. Hindsight and Applicant's teachings must therefore now be used to reconstruct a novel method for making the present structure. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

While applicant's take issue with the proposed combination, even if a person of ordinary skill in the art would find it obvious to combine the teachings of Suzuki et al. and Mackay as suggested, the claimed features still would not be met.

With regard to Claim 1, Suzuki et al. and Mackay fail to disclose or suggest a page object representing an ordered media attribute, a first user input device for selectively associating visual representations of document and page objects, and a second user input device for: creating page objects which is operative to allow selection of ordered media attributes, setting values of the ordered media attributes and selection of one or more pages to apply to the ordered media attribute(s).

With regard to Claim 15, Suzuki et al. and Mackay fail to disclose or suggest a visual representation of ordered media pages to be inserted in a document on a display according ordered media attributes.

With regard to Claim 35, Suzuki et al. and Mackay fail to disclose or suggest displaying a visual representation of ordered media pages to be inserted into a document on a display according to ordered media attributes.

For these reasons, applicant's respectfully submit that Claims 1-3, 15 and 35 are not obvious over Suzuki et al. in view of Mackay and withdrawal of the rejection is hereby requested.

Claims 4-5, 16 and 36 are rejected as being obvious over Suzuki et al. in view of Mackay and further in view of Quinion.

As the Applicant's have already demonstrated, a combination of Suzuki et al. and Mackay doesn't obviate the claimed invention because of the

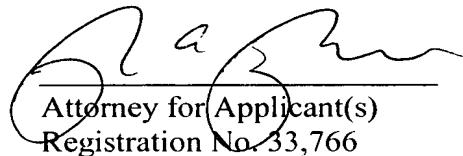
lack of motivation in either of these references to make the combination, and because the combination doesn't teach or suggest all of the claimed invention. Claims which further depend on this combination are therefore not obvious. Further combining of Quinon is the utilization of impermissible hindsight to try to reconstruct the present claimed invention.

Claims 6-14, 17-34, and 37-54 are rejected as being obvious over Suzuki et al. in view of Mackay and further in view of Sklut et al..

As the Applicant's have already demonstrated, a combination of Suzuki et al. and Mackay doesn't obviate the claimed invention because of the lack of motivation in either of these references to make the combination, and because the combination doesn't teach or suggest all of the claimed invention. Claims which further depend on this combination are therefore not obvious. Further combining of Sklut et al. is the utilization of impermissible hindsight to try to reconstruct the present claimed invention.

In view of the above reasons, it is submitted that claims 1-54 are not obvious over the combined teachings of Suzuki et al., Mackay, Quinon, and Sklut et al. and withdrawal of the rejection of these claims is respectfully requested.

Respectfully submitted,



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